

## **REMARKS**

### **Claim Amendments**

Claim 29 was amended to recite “wherein the web spans a distance between the two chords, and at least one of the plurality of spaced stabilizing members comprises a punched out opening or flange extending across more than half but less than all of the distance between the two chords.” Support for this amendment can be found in the application as filed, in particular on page 8, lines 3-8, and in figures 1 and 2. It should be noted that in figure 2 the flanges and the openings they surround extend across more than half but less than all of the distance between the two chords. No new matter was added.

Claim 30 was amended to recite “the punched out opening comprise at least forty percent of the area of the web.” Support for this amendment can also be found on page 8, lines 3-8, and in figures 1 and 2. No new matter was added.

Claim 32 was amended to recite “sets of the flanges are arranged in trapezoidal patterns coupled together to form trapezoidal stabilizing members projecting outward from the web.” As with the amendments to claims 29 and 30, support for this amendment can be found on page 8, lines 3-8, and in figures 1 and 2. No new matter was added.

Claims 33, 35, 37, and 39 were amended to maintain consistency with claim 29. No new matter was added.

### **Buecker (US6131362) - 35 USC § 102 and § 103**

Claims 29-42 were rejected as being anticipated by or obvious in view of Buecker. The applicant disagrees in regard to the form of the claims prior to the current amendments, and especially in view of the amendments set forth herein.

**Claim 29** recites “a substantially open and flat web having a plurality of spaced stabilizing members....” The Office and the Applicant apparently disagree on whether Buecker teaches or suggests a weight bearing element that comprises “a substantially open” web. However, in an attempt to more quickly obtain allowed claims, the Applicant has chosen to amend claim 29 to further recite that the weight bearing element comprises two chords and that “wherein the web spans a distance between the two chords, and at least one of the plurality of spaced stabilizing members comprises a punched out opening or flange extending across more than half but less than all of the distance between the two chords.”

The Office previously relied on “holes 74” of Buecker as being stabilizing or punched out openings. Holes without projecting edges as shown in Buecker are not stabilizing, and are likely not punched out. Moreover the holes 74 of Buecker are (see column 4 lines 53-56) “sized to receive pipes and/or wires”, i.e. simply to allow elongated object to pass through the joist. As such, Buecker does not teach or suggest or motivate a “web having a plurality of spaced stabilizing members” wherein “at least one of the plurality of spaced stabilizing members comprises a punched out opening or flange extending across more than half but less than all of the distance between the two chords.” Since Buecker does not teach, suggest, or motivate a weight bearing element as claimed in claim 29, Buecker does not anticipate or obviate claim 29, or any claims dependent on claim 29.

**Claim 30** recites “the stabilizing members are formed from punched out openings, and the punched out opening comprise at least forty percent of the area of the web.” The openings 74 that the Office relies on are not likely to be punched out as their edges are flush with the adjacent joist body. Moreover, those openings do not comprise “at least forty percent of the area of the web.” As such, Bucker does not anticipate or obviate claim 30.

**Claim 31** recites that “the stabilizing members are flanges”, and claim 29 recites that at least one of the flanges extends “across more than half but less than all of the distance between the two chords.” Overlapping portion 96 extends along the length of the joist, but does not extend across more than half but less than all of the distance between the two chords.

**Claim 32** recites that “sets of the flanges are coupled together to form trapezoidal stabilizing members projecting outward from the web.” Buecker does not teach, suggest, or motivate such stabilizing members and thus does not anticipate or obviate claim 32. It should be noted that simply modifying the shape of holes 74 of Buecker would not satisfy claim 32.

**Claim 38** recites that the element comprises “a fill material in the cavity of at least one of the two chords.” However Buecker does not teach, suggest, or motivate filling the cavity of a chord of an element as claimed. As such, the Buecker does not anticipate or obviate claim 38.

**Claim 41** recites each chord having at least six sides. Weight bearing elements comprising six sided chords are not anticipated or obviated by Bucker as it does not teach, suggest, or motivate elements having such chords.

**Claims 32, 38, and 41** were rejected by the Office at least partially on the basis that claimed members were “within the skill of a worker in the art”. Applicant respectfully submits

that the fact that the ability to produce an apparatus as claimed is not sufficient to overcome a failure to provide references that teach, suggest, or motivate all of the elements of a claim.

Applicant further submits that the inclusion of an element is only a "design choice" as the Office appears to use the phrase if the element was previously known. However, the Office does not provide any reference that evidences that trapezoidal stabilizing members, filled chords and/or six sided chords were known such that one of average skill would be able to choose them.

In the Office action the Office also asserts that "the material left between the holes can also provide a teaching for a plurality of spaced stabilizing members as well as flanges." However, the material left between the holes in Buecker are not openings, and even if they could be consider flanges, do not "extend across ... less than all of the distance between the two chords."

#### **Request for Allowance**

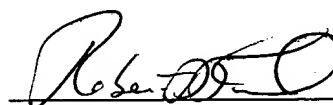
Claims 29-42 are pending in this application. The applicant requests allowance of all pending claims. If the Office is disinclined to allow a majority of the claims, Applicant requests that the Examiner for this matter contact his representative to discuss this matter to more quickly conclude prosecution of the pending claims.

Respectfully submitted,

Rutan & Tucker, LLP

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By: \_\_\_\_\_



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